

As discussed by the Court of Appeals for the Federal Circuit, a proper conclusion of obviousness under 35 U.S.C. § 103 requires that there be some motivation in the prior art that suggests the claimed invention as a whole:

[A]n Examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” [Citations omitted] To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show motivation to combine the references that create the case of obviousness.

*In re Rouffet*, 149 F.3d 1350, 1357; 47 USPQ2d 1453, 1457-1458 (Fed. Cir. 1998). As further explained by the Federal Circuit:

Our case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. See *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.” *Id.*

“When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.” *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998) (citing *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)).

*Ecolchem, Inc. v. Southern California Edison Co.*, 56 USPQ2d 1065, 1072-73 (Fed. Cir. 2000).

The showing of the motivation to combine must be “clear and particular.” See, e.g., *C.R. Bard*,

*Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998); *Teleflex, Inc. v. Ficosa North Am. Corp.*, 63 USPQ2d 1374 at 1387 (Fed. Cir. 2002).

Claims 1-5 and 16-19 are patentable over the cited references

The Office action's conclusion of obviousness is based on improper hindsight by selectively choosing features from the cited references and ignoring various features recited in the claims.

For example, the pending claims relate to dynamic image code communications. Although the Isu et al. patent relates to image decoding apparatus, the Iwakiri et al. patent relates to decoding techniques for use in mobile radio communication systems such as cellular telephones (col. 1, lines 7-12; col. 4, lines 40-45). There is no suggestion that the techniques of the Iwakiri et al. patent might be applicable to other types of communication systems such as image code communications.

The Office action alleges that although the Iwakiri et al. patent fails to teach the input data is in the form of MPEG encoded data, the Isu et al. patent does. The Office action then concludes, erroneously, that “[s]ince various forms of input encoded data could have been transmitted to the decoding method of this application, it would have been obvious to one of ordinary skill to use MPEG data as opposed to CDMA data for the input data transmitted to the decoder.” (Emphasis added) Whether something “could have been done” is not the proper test for determining obviousness under section 103. Instead, as indicated by the court decisions above, there must have been a “clear and particular” motivation to combine the references in such a way to obtain the claimed subject matter. In the present case, there is no such motivation.

The Iwakiri et al. patent discloses various units for detecting and calculating errors, including a unit 6 that increments a count value when an error is detected (see col. 5, lines 60-64). However, applicant finds no disclosure or suggestion of “counting an amount of dynamic image codes received” or “correcting the amount of the counted dynamic image code according to the counted defective amount . . .” as recited in claim 1. Claim 16 includes similar features

that are not disclosed or suggested. Indeed, the Office action does not even appear to address those feature, but instead relies on general conclusions.

The dependent claims include additional features that make those claims independently patentable.

Furthermore, the Office action makes other unsupported, conclusory remarks. For example, in connection with claim 2, the Office action states that one "can assume that part of the of the reason for the inventions of Iwakiri et al. and Isu et al. is to take into effect transmission errors." However, the Office action fails to explain how or why one of ordinary skill in the art would draw that conclusion in the absence of such an explanation in the references themselves. For that additional reason, claim 2 should be allowed.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

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Page : 5 of 5

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Respectfully submitted,

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